

REMARKS**A. INTRODUCTION**

Claims 1-58 are pending and rejected.

This paper is filed with an RCE.

No amendments are being made.

The filing date of the parent application (08/920,116) predates that of the Herman provisional, making Herman an improper § 102(e) reference.

B. REQUEST FOR CONTINUED EXAMINATION (RCE)

This paper is being filed in response to an Advisory Action mailed September 13, 2005, and after a Notice of Appeal mailed September 19, 2005. We have decided to forego the appeal at this time for business reasons and in light of the argument presented below, which would likely have resulted in re-opening of prosecution. A Request for Continued Examination (RCE), along with the appropriate fee, is being filed concurrently to ensure consideration of these remarks.

C. EFFECTIVE FILING DATES

On April 29, 2003, we added a claim to the benefit of priority of U.S. Patent Application No. 08/920,116, filed August 26, 1997, which issued as U.S. Patent No. 6,119,099 ("Walker '099"). Walker '099 in turn claims priority to an earlier-filed application, U.S. Patent Application No. 08/822,709 filed March 21, 1997.

Walker '099 was used previously by the present Examiner as an anticipatory reference against all of Claims 1-4, 6-7, 21-24, 28-31, 40-44, 51, and 56 and in combination with various other references against all of the other pending claims (Claims 5, 8-20, 25-27, 32-39, 45-50, 52-55, 57, and 58). [See Office Action mailed November 13, 2002, pages 2-7].

The record thus clearly indicates that the Examiner believes that all of the subject matter of at least all of Claims 1-4, 6-7, 21-24, 28-31, 40-44, 51, and 56 (which includes all of the independent claims) is disclosed and enabled in Walker '099. Accordingly, the record clearly indicates that the Examiner believes that the effective filing date for all of the claimed subject matter of the independent claims must be no later than August 26, 1997, the filing date of Walker '099.

D. SECTION 102(E) AND 103(A) REJECTIONS

All of the pending claims (Claims **1-58**) stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,341,353 issued to Herman et al.

(“Herman”) or under 35 U.S.C. 103(a) as unpatentable over Herman in view of U.S. Patent No. 6,161,059 issued to Tedesco et al. (“Tedesco”).

We respectfully traverse the Examiner’s Section 102(e) rejection and Section 103(a) rejections. Herman is not an appropriate § 102(e) reference. We respectfully submit that the Examiner has not established a *prima facie* case of anticipation or obviousness for any of the independent claims (Claims 1, 6, 44, 51, and 56) or any claims depending therefrom.

1. Herman provisional was filed after parent application (Walker ‘099)

Herman claims priority to both U.S. Patent Application No. 08/834,027 (Martinez) and a provisional application. But the Examiner explicitly “has only relied upon the provisional application, filed 12 December 1998, to establish priority and provide an effective 102(e) date” and thus apparently has found that Martinez cannot support the subject matter of Herman relied upon by the Examiner in making the rejections. [See Office Action mailed June 2, 2005, page 3].

We respectfully request consideration of the following evidence made of record:

- The present application properly claims priority to Walker ‘099.
- The Examiner has made a finding (with which we neither agree nor disagree) that Walker ‘099 anticipates (i.e. discloses and enables) all of the subject matter of Claims 1-4, 6-7, 21-24, 28-31, 40-44, 51, and 56.
- The Examiner is relying upon only the provisional application to establish that Herman is a proper § 102(e) reference for the asserted subject matter.
- The provisional application (filed 12/12/98) was filed after the application for Walker ‘099 (filed 08/26/97).

Accordingly, even if the provisional application properly supports all of the subject matter of Herman asserted against the pending claims (which we dispute), Herman cannot be a proper § 102(e) reference for all of the claimed subject matter of any of at least Claims 1-4, 6-7, 21-24, 28-31, 40-44, 51, and 56, because the § 102(e) priority date relied upon by the Examiner for Herman (12/12/98) is after an earlier priority date (08/26/97) the Examiner has already identified for that claimed subject matter. Accordingly, the Examiner has not established a *prima facie* case of anticipation for at least Claims 1-4, 6-7, 21-24, 28-31, 40-44, 51, and 56.

The Examiner also has not made any finding that any claim is not entitled to an effective filing date of August 26, 1997 (or earlier). Accordingly, the Examiner

has failed to establish a prima facie case of anticipation or obviousness for any of pending claim. We respectfully request the Examiner withdraw the rejections of all of the pending claims (Claims 1-58).

2. Claim: Official Notice is unsupported

Further with respect to Claim 55 (which depends from Claim 51), we noted during a review of the file that the Examiner purports to rely on a combination of Herman and Tedesco. In fact, the Examiner does not refer to Tedesco at all, but is actually relying upon asserted subject matter for which no supporting evidence has been made of record. We request a reference or other evidence to support the Examiner's assertions.

The Board is not permitted to accept conclusory, unsupported findings made by the Primary Examiner that are not supported by substantial evidence made of record. All findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. In re Gartside, 203 F.3d 1305, 1315, 53 U.S.P.Q.2D 1769, 1775 (Fed. Cir. 2000).

The underlying factual determinations on which a conclusion of obviousness is allegedly based are reviewed to ascertain whether they are supported by substantial evidence. In re Kumar, 418 F.3d at 1365 (citing Gartside, 203 F.3d at 1316). Unsupported assessments of the prior art are unacceptable for purposes of review. "Rather, the Board must point to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise." In re Zurko, 258 F.3d at 1385-86. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense,'" nor may the Board simply reach conclusions based on its own understanding or experience. In re Zurko, 258 F.3d at 1385; Lee, 277 F.3d at 1344. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." Lee, 277 F.3d at 1344.

In contrast to the requirements outlined above, the Examiner has simply relied upon unsupported assertions of what was known and what would have been obvious. Specifically, the Examiner has not indicated any tangible evidence of record that "providing signatures to approve transactions between two parties is old and well known in the financial arts," nor has the Examiner indicated any evidence or reasoning as to why (even if it were known) that knowledge would have suggested specifically the recited feature of Claim 55: *wherein the record of charge contains separate signature lines for the purchase amount and the offer*. Without such supporting evidence for either the asserted teaching or the asserted

motivation, the Examiner cannot have established a prima facie case of obviousness.

3. Additional Comments

Further, we still do not believe the record supports the Examiner's reliance on Herman as a § 102(e) reference for all of the subject matter relied upon. In particular, the rejection of each of the independent claims (Claims 1, 6, 44, 51, and 56) depends explicitly on the following specific portion(s) of Herman: Column 47, lines 8-19 and/or Column 47, lines 15-19. The Herman provisional does not adequately support that disclosure of Herman. In the Advisory Action, the Examiner asserted: "As mentioned above, the provisional application teaches that LEDOs are verifiable and are efficient for legal business issues. Such negotiations are a clear example of a legal and business issues." We do not necessarily agree or disagree with this assertion. We also do not necessarily agree or disagree with the Examiners' assertion during the interview that Column 44, lines 5-20 and 33-44 of Herman are adequately supported by the paragraph bridging pages 9 and 10 of the Herman provisional. We reserve the right to address in the future each of these and other assertions as to the teachings of the cited references (and/or evidence of priority of such asserted subject matter).

Our silence with respect to the Examiner's other various assertions of record not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, or the Examiner's interpretation of claimed subject matter, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case of anticipation or obviousness for any of the pending claims, for the reasons stated in this paper, we need not address the Examiner's other assertions at this time.

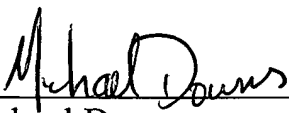
E. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date



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